

REMARKS

Initially, Applicants would like to thank Examiner Lacyk for the indication that Claims 1-5, 10-17, 19, 24, 25, 28-32, and 42 are allowed. Claims 6-10, 20-21, 24-25, 28-39, 41-46 have been amended according to 37 C.F.R. § 1.73 for Reissue Applications. Reconsideration and allowance of the remaining claims are respectfully requested in view of the foregoing amendments and following remarks.

Claim 33 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite because it depends from a canceled claim. Claim 33 has been amended to depend from pending Claim 6.

Claims 6-9, 20, 21, 33-39, 41, and 43-46 have been rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the Office Action states that in the parent application, Serial Number 08/219,179, Claim 15 was rejected on art while Claim 16 was indicated as allowable. In the response filed November 15, 1994, the attorney incorporated the language from Claim 16 into Claim 15 to overcome the rejection, making Claim 15 allowable. In particular, the claim was amended to add "a cut-out."

As discussed with Examiner Lacyk in a telephone interview on July 31, 2003, independent Claims 6, 34, and 44 have been amended to recite the broader feature of "a window" rather than "a cut-out."

In Ex parte Eggert et al., Appeal No. 2001-0790, decided May 29, 2003, the Board of Patent Appeals and Interferences found that subject matter narrower than that of the canceled claim and broader than that of the allowed claim is not surrendered subject matter and therefore, is not barred by the recapture rule. In other words, the Board said it was

permissible for an applicant to replace a feature added for purposes of obtaining allowance of the original claims with a broader recitation.

In the present application, the term "cut-out" has been removed from pending Claims 6, 34, and 44 and replaced with the broader term "window." The term "window" as used herein, is intended to mean a portion of a catheter which is substantially transparent to the radiation of the radioactive dose.

Support for the amendments to Claims 6, 34, and 44 is provided in the application at column 3, lines 29-31 and column 3, lines 19-21. The claims have also been amended throughout to remove the "means" language for improved clarity of the claims. Independent Claims 6, 34, and 44 are now believed to be in condition for allowance.

Claims 41, 43, and 45, have been rewritten in independent form. These claims relate to an embodiment in which "the radioactive dose is incorporated into a liquid for delivery." New Claim 47 also includes this feature. Thus, these claims relate to an embodiment which was not specifically recited in the patent claims. This embodiment is narrower in a material respect than any subject matter that was given up during prosecution because the claims recite incorporation of a radioactive dose into a liquid for delivery. For example, the radioactive materials described at column 4, lines 7-8 of the application, may be delivered in particle, pellet, seed, or other form incorporated in a liquid.

Claims 41, 43, 45, and 47 are significantly different from any claims canceled during prosecution of the patent and thus, do not evoke the recapture rule and should be allowed.

All outstanding matters in the Office Action are believed to be addressed by the foregoing amendments. In the event that there are any questions concerning this

Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,

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